

## **REMARKS**

This paper is filed in response to the Office Action dated January 6, 2004. As this paper is filed on May 6, 2004 and is accompanied by a petition for a one-month extension and fee (\$110), the paper is timely filed.

### **I. Status of Amendments**

Claims 1-56 were pending prior to this amendment. By this amendment, applicant amends claims 1, 22, 28, 43 and 53, and cancels claims 10, 23-27, 41, 52 and 56 without prejudice to refile. Thus, claims 1-9, 11-22, 28-40, 42-51 and 53-55 are now pending.

### **II. Response to Office Action**

#### **A. General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus,

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '\_\_\_\_\_' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. § 112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. § 112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of § 112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement."). The written description requirement of § 112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112").

#### **B. The January 6 Office Action**

In the January 6 Office Action, claims 1-3, 5-7, 9, 12-21, 23, 24, 26, 28-39, 43-51 and 53-55 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly unpatentable over Luciano, Jr., et al. (U.S. Patent No. 6,050,895). Further, claims 4, 40, and 42 were rejected under 35 U.S.C. § 103(a) as allegedly

unpatentable over Luciano, Jr., et al. in view of Walker et al. (U.S. Patent No. 6,142,872) and claims 8, 11, 22, 25, and 27 were rejected as allegedly unpatentable over Luciano, Jr., et al. Additionally, claims 10, 41, 52, and 56 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form.

By this amendment, applicants have amended claims 1, 28, 43 and 53 to incorporate the limitations of claims 10, 41, 52 and 56, respectively. Thus, claims 1, 28, 43 and 53 should now be allowable.

Moreover, claims 2-9 and 11-22 depend directly or indirectly from claim 1; claims 29-40 and 42 depend directly or indirectly from claim 28, claims 44-51 depend directly or indirectly from claim 43 and claims 54 and 55 depend directly or indirectly from claim 53. As claims 1, 28, 43 and 53 are now allowable, so too are claims 2-9, 11-22, 29-40, 42, 44-51, 54 and 55 by virtue of their dependency from claims 1, 28, 43 and 53, as amended.

**C. The Supplemental Information Disclosure Statement**

Applicant files herewith a Supplemental Information Disclosure Statement. In the Supplemental Information Disclosure Statement, applicant cites U.S. Patent Application No. 10/027,888 ("the '888 application") and U.S. Published Application No. 2003/0114218, which is the published version of the '888 application. Additionally, applicant cites the most recent amendment (dated November 18, 2003) and Office Action (dated January 21, 2004) in regard to the '888 application (in particular, note claim 50, found to be allowable in the '888 application if rewritten). For ease of reference, the November 18 amendment and the January 21 Office Action have been appended to the end of this document as well. Further, applicant cites those documents not previously cited to or by the U.S. Patent and Trademark Office in the above-mentioned application that were cited to or by the U.S. Patent and Trademark Office during the prosecution of the '888 application, with the exception of U.S. Patent No. 5,796,716, which is believed to have been cited in error.

The undersigned also notes the following. The named inventor of the '888 application is the named inventor of the above-mentioned application. Moreover, the assignee of the '888 application at the time of filing, Anchor Gaming, was the assignee of the above-mentioned application at the time of filing. Further, the '888 application and the above-mentioned application were both transferred from Anchor Gaming to the present

assignee, IGT. However, neither the undersigned nor his firm prepared the above-mentioned application or the '888 application, and the undersigned did not become aware of a relationship between the subject matter of the '888 application and the subject matter of the above-mentioned application until recently, when he reviewed the Office Action issued in regard to the above-mentioned application.

A similar Information Disclosure Statement is being prepared for submission in the '888 application in regard to the above-mentioned application, its prosecution, and the documents cited by and to the U.S. Patent and Trademark Office in regard to the above-mentioned application that have not previously been cited in the '888 application.

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

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